

REMARKS

Claims 4, 7, and 26-47 are pending in the present application. All of these claims are ultimately dependent upon independent claim 1, which has been restricted out by a final restriction requirement placed in this application by the Office Action. Applicant has also amended claims 18-21, which claims are also identified as having been withdrawn, and 39-42 to clarify that the claimed adhesive therein is ester-based polyurethane with enhanced hydrolytic stability. Support for these amendments is found throughout the specification, e.g., in Figures 1-6, of the present application. No new matter has been introduced by way of these amendments.

Turning to the specific rejections, in paragraph 2 & 3 the Office Action has rejected claims 1, 4, 7, and 27 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,447,462 issued to Smith et al. (“Smith”), a reference cited by the applicant to the Patent Office.

Smith does not anticipate the claimed invention

Smith plainly does not teach all of the limitations of claim 1, and as a consequence, it also does not disclose the limitations of any of the claims ultimately dependent upon it, the aforementioned rejection of claims 1, 4, and 7 must be withdrawn. For example, Smith does not teach, disclose or suggest prelamination “on the first fabric in the form of a film tacked on the first fabric by application of pressure and temperature less than that required for lamination.” Contrary to the allegation made by the Office Action, the cited portions of Smith, i.e., the abstract and column 9, teach the use of webs instead of films. Smith is concerned in the cited portions with selective orientation of fabrics with respect to their elongation directions. In view of this fatal deficiency of Smith, the rejection of claim 1, and all claims dependent upon it under 35 U.S.C. § 102(b) must be withdrawn.

Smith also does not teach all of the limitations of claim 27 for the reasons similar to those discussed above for claims 1, 4 and 7 since it does not disclose the adhesive layer of claim 27. An adhesive layer is at a minimum a layer comprising a relatively defined composition and thickness of an adhesive, which is not satisfied by a web, which has regularly patterned frequent pores therein. A web is a latticed structure by definition, see, e.g., the American Heritage College Dictionary, third edition, published by Houghton Mifflin Company, and therefore a substantial part of it is in the form of pores. Therefore, the rejection of claim 27 must also be withdrawn. Therefore, the rejection of claim 27 under 35 U.S.C. § 102(b) must be withdrawn.

Smith and Kollmanthaler do not make the claimed invention obvious

The Office Action has further rejected, in paragraphs 4-6, claims 26 and 28-47 under 35 U.S.C. § 103(a). Specifically, claim 26 has been rejected under 35 U.S.C. § 103(a) over Smith in view of US Patent No. 5,967,876 issued to Kollmanthaler et al. (“Kollmanthaler”). In paragraph 6, claims 28-47 have been rejected under 35 U.S.C. § 103(a) over Smith in view of US Patent No. 5,984,762 issued to Tedeschi et al. (“Tedeschi”).

As to claim 26, the Office Action concedes that Smith does not teach the use of an insert wire. This deficiency of Smith is allegedly cured by Kollmanthaler with the necessary motivation allegedly provided by the desire to provide support to the wearer of the garment. Applicants note that Smith does not indicate any deficiency as to support in laminates made in accordance with its teachings. Indeed, it notes in the abstract itself that its laminate is useful for forming a “side support of a brassiere” or the “rear control support of a panty” and the like. Thus, there is no real motivation to combine Smith with Kollmanthaler.

Be that as may, even if combined, there is no teaching, disclosure or suggestion in Kollmanthaler of prelamination or tacking or use of an adhesive film as recited in claim 1, on which the rejected claim 26 is ultimately dependent. Therefore, the combination of Smith and Kollmanthaler fails to teach all of the limitations of claim 26, and the rejection of claim 26 must be withdrawn.

Smith and Tedeschi do not make the claimed invention obvious

As to claims 28-47, the Office Action concedes that Smith also does not teach the use of a cushioning strap. This deficiency of Smith is allegedly cured by Tedeschi, which is “concerned with the creation of a bra strap.” However, since the presumption for making this rejection is flawed, the rejection should be withdrawn.

Product by Process Considerations

The Office Action appears to allege that if a prior art product appears to be similar to that made by a claimed process rejection of the claims directed to the product is to be made. Although possibly justifiable for substantially identical products, this presumption is not appropriate in this case since the products made are neither admitted nor disclosed to be the same as the prior art products. Indeed, bras made by the disclosed process are disclosed to be superior to the prior art bras. Some factors distinguishing them from prior art bras are the use of thinner adhesive layers, the nature of the adhesive materials displaying tackiness and improved hydrolytic stability, the form of the product by way of being lighter, sturdier and in its construction itself. These considerations are significant in view of the nature of the art

addressed in the specification itself. For instance, some differences from bras made by the Smith process are described in paragraph 12 of the published application of the applicant.

The Office Action further asserts that its rejections are based on the (unsupported) presumption that the bra made by combination of Smith and Tedeschi is “identical or only slightly different” than the bra made by the method of the applicant. Since neither Tedeschi nor Smith teach, disclose or suggest making of molded breast cups that overcome the difficulties discussed in the present application, the presumption that they do so lacks basis. There are additional reasons that show that the adopted presumption is without justification.

The articles made in accordance with the teachings of Smith are clearly not identical to those made in accordance with the claimed invention. This is discussed in the very first paragraph in the ‘Detailed Description of the Invention,’ which discloses that the applicant has “determined that adhesives in the form of films are preferable to adhesives in the form of webs for laminating fabrics together. This is due to, in part, the improved consistency in adhesion following lamination made possible by films.” Merely combining Smith with Tedeschi does not make the web adhesive any more effective. Tedeschi itself discloses a preference for web adhesives, including polyurethane webs, noting that “even when heavier amounts of adhesive are used” the product will not discolor and the like. See, column 5, line 66-column 6, line 21. No example of a film is actually provided in Tedeschi. This is in contrast to the thin films and limited adhesive use made possible by the present invention. Tedeschi is actually teaching a method for using more adhesive indicating that the adhesives disclosed therein are not satisfactory for thin films unlike those in the pending application. Therefore, an identity or substantial similarity between the products must not be presumed.

While Tedeschi discusses the problems of aligning the various layers and its solution in Figure 7, it does not disclose prelamination as a technique to assist in alignment of two layers. Products made with its process will have more alignment errors and excess adhesive in view of its own discussion of the problems in making laminated fabrics.

Applicants also point out that claim 27 recites a brassiere comprising “a third layer of woven, stretch fabric placed in an area suitable for bubble molding such that the third layer, having an adhesive layer **prelaminated** thereon, is sandwiched between the at least two layers,” (emphasis added), which limitation clearly cannot be met by the disclosure of Smith or Tedeschi. Moreover, following bubble molding the product is also not identical or substantially similar to that of Smith or Tedeschi since laminated padded/lined bras are also not disclosed by Smith or Tedeschi. Neither reference teaches making fabric laminates having a prelaminated layer therein or a padded cup, which poses technical challenges of its

own as is discussed in the specification of the present application. Neither Smith nor Tedeschi, alone or in combination, disclose a padded brassiere.

Therefore, the presumption that the claimed layered brassiere is “identical or only slightly different” from brassieres in the cited art lacks support. However, even if the brassiere of claim 27 were to be considered to have an adhesive layer prelaminated on a sandwiched layer (as opposed to having fully formed cups only), it still will not be disclosed, or even suggested by Smith and Tedeschi, alone or in combination. Such a brassiere may then be further processed to add straps or subjected to bubble molding as is described in paragraph 50 of the present application.

In the specification of the present application, while discussing the Smith reference in paragraph 12, applicant noted that in addition to handling challenges posed by the adhesive webs taught by Smith, it also results in the introduction of pores in the finished article. This is a straightforward consequence of the taught use of adhesive webs by Smith (and Tedeschi) and Smith’s concern with laminate elongation characteristics. In view of this difference, absent a showing that such undesirable pores are also present in bras made by the method of the applicant, the possible presumption discussed above cannot be applied when considering bras made in accordance with the teachings of Smith.

Neither Smith nor Tedeschi disclose prelamination as a method for handling thin adhesive films. Therefore, presuming that such thin films are present in brassieres made in accordance with their disclosures begs the question. Consequently, the use of the adhesive layer with the thickness recited in claims 32-38 or the use of ether-based polyurethane is not taught, disclosed or suggested by either Smith or Tedeschi.

Further, in view of the customary use of ester-based polyurethane or even the preference for ternary resin system polyurethane of Tedeschi, disclosure or use of ether-based polyurethane cannot be presumed just to reject claims 35-38. The cited art simply does not support such presumptions. Smith does not even make any reference to polyurethane or the use of thin adhesive layers. Similarly, the distinctive properties of ‘polyester-based polyurethane with enhanced hydrolytic stability’ as recited in claims 39-42 cannot be presumed. Such a presumption needs express support to avoid summary dismissal of one of the problems solved by the invention as not being worthy of a solution.

Applicant disclosed and claimed in claims 43-45 the use of adhesives with desirable hydrolytic properties, which properties cannot be presumed to also be present in the adhesives disclosed in either Smith or Tedeschi in view of applicants discussion of the problem in prior art bras. In particular, the ester based polyurethane is not the same as the ether based polyurethane as illustrated in Fig. 4 and 5 of the present application. Therefore,

bras covered by claims 43-45 cannot be presumed to be “identical or only slightly different” from cited art bras without more. Therefore, the rejection of claims 43-45 should be withdrawn since it is based on the unsubstantiated and faulty premise that such adhesive layers are actually taught, disclosed or suggested in the cited art to result in identical or almost similar bras. Therefore, the rejection of claims 32-45 based on this premise must be withdrawn.

As to claim 46, it is improper to presume that a padded and/or layered brassiere can be made using techniques and materials known in the cited art in view of the difficulties in bubble molding. This is particularly true for large cup sizes such as a size D cup. Therefore, the rejection of claim 46, and axiomatically that of claim 47 dependent upon it must be withdrawn as well.

CONCLUSION

All of the various arguments and grounds for the rejection of pending claims 4, 7, 26-47 as well as the specifically rejected independent claim 1 have been overcome. No new matter is introduced by way of any of the amendments. Therefore all of the pending claims, including those dependent on independent claim 1 are now allowable.

No fee is believed to be due for this submission in addition to the fee for the accompanying petition for an extension of time for three (3) months, which is estimated to be \$ 475.00 for a small entity. In the event that any additional fee is required, please charge the required fee to JONES DAY Deposit Account No. 50-3013.

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Respectfully submitted,



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